

REMARKS

In the Office Action dated June 30, 2008, all of the currently pending claims were examined with the result that, apparently, all of the currently pending claims were rejected, and the Examiner made the rejection final. In response, Applicant has amended claims 1 and 20, cancelled claims 8, 23, 24 and 25, and added new claims 41-51. In view of the above amendments and following remarks, reconsideration of this application is requested.

Applicant has stated that "apparently" all claims were rejected because on the "Office Action Summary" page, the Examiner indicated that claims 9 and 14 were allowed, but on page 2 of the Office Action, the Examiner indicated that "no claim is allowed," and further both claims 9 and 14 were indicated to be rejected on the basis of obviousness-type double patenting on page 3 of the Office Action. In addition, on page 4 of the Office Action the Examiner objected to claim 14 as being directed toward a non-elected invention. Finally, the Examiner indicates at the bottom of page 4 that claims 9 and 14 "are allowed." Applicant requests clarification from the Examiner whether in fact claims 9 and 14 are allowed or rejected.

Before turning to the rejections of record, Applicant would like to briefly discuss the amendments made to the claims via the present response. More specifically, claim 1 has been amended to define R as a retinoyl of a retinoid selected from a Markush grouping which was set forth in original claim 8. In other words, the compounds listed in original claim 8 have been incorporated into claim 1 via the present response. Accordingly, claim 8 has been cancelled.

With respect to claim 20, the Examiner indicated that this claim was "broad and should be amended." Accordingly, Applicant has rewritten claim 20 to define the disease as one selected from the group consisting of psoriasis, or a cancer selected from skin cancer, leukemia, colon cancer, breast cancer, prostate cancer, ovarian cancer, neuroblastoma, and lung cancer, or a skin disorder selected from dermatitis, eczema, or keratosis. These diseases were originally set forth in claims 23-25, and thus the limitations of original claims 23-25 have been incorporated into claim 20 as amended. Thus, original claims 23-25 have been cancelled via the present response.

Finally, Applicant has added new claims 41-51. New claim 41 is an independent claim which is similar to original claim 1 except the retinoid ester has been limited to a tertiary alcohol attached to an all-trans-retinoic acid nucleus. This was done because the Examiner requested Applicant limit the substituent "R" to the elected species. Claim 42 is similar to original claim 3, except depending from new claim 41, and new claims 43-51 are similar to claims 21-22, 29-31 and 35-37, respectively, except all depending from new claim 41.

Applicant would now like to turn to the rejections of record. In the Office Action, the Examiner first rejects claims 1, 3, 4, 7-9 and 12-15 on the ground of obviousness-type double patenting in view of claim 18 of U.S. Patent 7,126,017. In response, Applicant filed a Terminal Disclaimer with the previous response dated March 31, 2008 in order to overcome this double patenting rejection. The Examiner in the current Office Action indicated that the double patenting rejection would be withdrawn when the Terminal Disclaimer has been approved by the USPTO. Applicant believes the previous Terminal Disclaimer filed should be approved, and requests the same from the Examiner. As a result, Applicant herein requests the Examiner withdraw the obviousness-type double patenting rejection of these claims.

In the Office Action, claims 1, 3, 4, 7-8, 12-15, 20-25, 29-32 and 35-38 were objected to as being directed toward a non-elected invention. The Examiner apparently requests that the non-elected invention should be cancelled from these claims. However, Applicant has already cancelled the non-elected invention via the previous Amendment dated March 31, 2008. In that previous Amendment, Applicant rewrote the claims to eliminate the secondary alcohols from the definition of the retinoid ester being claimed. Thus, all of the claims currently pending define only a retinoid ester containing a tertiary alcohol. Thus, Applicant believes these claims are not directed toward the non-elected invention and are now allowable. Applicant thus requests the Examiner withdraw the objection to these claims.

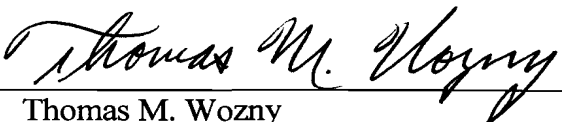
Finally, the Examiner indicates that the method claims will be joined if there are no §112 issues, but noted that original claim 20 was "broad and should be amended." Accordingly, Applicant has rewritten claim 20 via the present response to be limited to treating the diseases of original claims 23-25. Accordingly, Applicant believes there are no §112 issues remaining, and requests the Examiner allow all of the method claims.

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Reply to Office Action of June 30, 2008

An effort has been made to place this application in condition for allowance and such action is earnestly requested.

Respectfully submitted,

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